

Application No. 09/884,949
Response to Office Action dated October 4, 2004

REMARKS

Applicant would like to thank Examiner Jiang for the courteous and helpful Interview conducted in this case on November 15, 2004, which Applicant believes materially advanced prosecution in this case.

The Interview focused on the pending rejections under 35 U.S.C. §§ 102 and 103 which are based on U.S. patent 5,567,426 (“Nadaud”). During the Interview, Applicant pointed out that Nadaud discloses myriad dimethicone copolyols containing both oxypropylene and oxyethylene groups, but only one dimethicone copolyol containing oxyethylene groups, (see, col. 3, lines 33 and 34), and that Nadaud neither teaches, suggests, nor recognizes any benefits associated with the dimethicone copolyol containing only oxyethylene groups. Given the breadth of Nadaud’s disclosure, Applicant stated that the rejection under § 102 was improper. The Examiner appeared to agree with this statement, although she indicated that the “comprising only oxyethylene groups as oxyalkylene groups” language in the claims potentially raised concerns.

In view of the discussion at the Interview, Applicant has amended all previously pending claims (claims 1-29) to require that the emulsifier be a “dimethicone copolyol in which the only oxyalkylene groups are oxyethylene groups.” Applicant respectfully submits that this non-limiting amendment not only addresses the Examiner’s potential concerns but also makes explicitly clear what was at least implicitly present in the claims as originally filed: the only oxyalkylene groups present are oxyethylene groups.

In view of the above, Applicant respectfully requests that the rejection under 35 U.S.C. § 102 be reconsidered and withdrawn with respect to claims 1-29.

Application No. 09/884,949
Response to Office Action dated October 4, 2004

With respect to the rejection of claims 1-29 under 35 U.S.C. § 103, no *prima facie* case of obviousness exists. As noted above, Nadaud neither teaches, suggests, nor recognizes any benefits associated with dimethicone copolyols containing only oxyethylene groups. What's more, the Condensed Chemical Dictionary reference does not compensate for these deficiencies of Nadaud. Accordingly, the rejection under § 103 is improper and should be withdrawn.

However, even assuming that a *prima facie* case of obviousness exists -- which is not the case -- the claimed invention yields "surprising and unexpected" results which are sufficient to rebut such a hypothetical *prima facie* showing of obviousness. These results are detailed in the present application.

Specifically, the examples set forth on pages 11-13 of the present application demonstrate that dimethicone copolyols containing only oxyethylene groups result in compositions having good cycle stability (stability over 5 days), whereas dimethicone copolyols containing both oxyethylene and oxypropylene groups do not (destability after 2 days). This difference in properties is neither taught, suggested nor recognized by Nadaud. Rather, Nadaud suggests that all dimethicone copolyols are alike and, thus, possess similar properties. One skilled in the art, following Nadaud's teachings, would not be led to the unique properties or characteristics of dimethicone copolyols containing only oxyethylene groups in the claimed compositions. In other words, such characteristics of the claimed dimethicone copolyols in the claimed compositions are unexpected and surprising given Nadaud's disclosure.

Application No. 09/884,949
Response to Office Action dated October 4, 2004

In view of the above, Applicant respectfully submits that the rejection of claims 1-29 under 35 U.S.C. § 103 is improper and should be withdrawn.

Regarding new claim 30, Nadaud neither teaches nor suggests the subject matter of this claim. As discussed during the Interview, Nadaud discloses triple emulsions. (See, for example, the Title). In contrast, claim 30 is directed to a normal emulsion, a water-in-oil emulsion. Nothing in Nadaud would lead one skilled in the art to the water-in-oil compositions set forth in claim 30. Accordingly, claim 30 is free of the cited art as well, and is in condition for allowance.

Finally, the Office Action rejected the pending claims under the judicially created doctrine of obviousness-type double patenting in view of U.S. patents 6,465,510, 6,331,306, 6,562,354 and 6,239,174. In view of the following comments, Applicant respectfully requests reconsideration and withdrawal of these rejections.

The claims in U.S. patent 6,331,306 require the presence of a dimethicone copolyol containing both oxypropylene and oxyethylene groups, and the claims in U.S. patent 6,562,354 are directed to alkyldimethicone copolyols generally having specific HLB values. None of these claims in these patents relates to dimethicone copolyols containing only oxyethylene groups. Accordingly, such claims cannot suggest the presently claimed invention which relates to dimethicone copolyols containing only oxyethylene groups.

Moreover, the claims in U.S. patents 6,239,174 and 6,465,510 require specific pH ranges as well as the presence of ascorbic acid (or a salt thereof). The '174 claims also require the presence of specific silicone oils. Nowhere do the '174 or '510 claims suggest

Application No. 09/884,949
Response to Office Action dated October 4, 2004

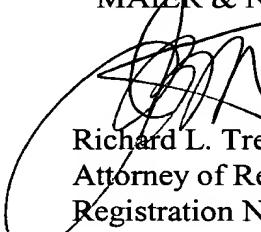
emulsions containing the required aqueous phase or the required oily phase to silicone emulsifier weight ratio of the presently claimed invention.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the double patenting rejections in this case.

Applicant believes that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Richard L. Treanor
Attorney of Record
Registration No. 36,379

Jeffrey B. McIntyre
Registration No. 36,867

Customer Number

22850

Tel #: (703) 413-3000
Fax #: (703) 413-2220